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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,014	10/16/2003	David Duncan	06318.00001	7409

22908 7590 01/30/2006

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EXAMINER	
GRAY, JILL M	

ART UNIT	PAPER NUMBER
1774	

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/687,014	DUNCAN, DAVID	
	Examiner	Art Unit	
	Jill M. Gray	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) *9-19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The rejection of claim 8 under 35 U.S.C 112, second paragraph as being indefinite is moot in view of applicants' amendments.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bower 2,767,113 in view of MacMurray 3,290,854 for reasons of record.

Bower teaches wire ties comprising a coating adhered to a surface of a metal wire, wherein the coating comprises a first and second plastic resin, per claim 1. The plastic resin is polyvinyl chloride and a lacquer of polyvinyl chloride, per claim 2. It is the position of the examiner that the polyvinyl chloride plastic and lacquer of polyvinyl chloride comprising ethyl alcohol would have different molecular weights. See column 1, line 70 through column 2 and line 13. Applicants should note that the language of "comprising a first and second plastic resin" does not exclude layers. Bower does not teach that his coating is textured. MacMurray teaches wire ties comprising plastic covered wire having greatly improved holding power, per claim 8, said wire ties having serrations or slits or notches in the plastic coating and wherein the plastic can be polyvinyl chloride. See column 1, line 10 and lines 68-71 and column 2, lines 17-25 and

line 51. It would have been obvious to the skilled artisan to modify the wire tie taught by Bower by including serrations in the plastic coating to improve the holding power of the tie. As to claim 6, MacMurray teaches that the plastic coating has a thickness within applicant's range. See column 2, line 58. Also, with respect to claims 6 and 7, limitations with respect to the thickness of the coating and wire diameter are drawn to the size, wherein changes in size are ordinarily not a matter of invention. Alternatively, plastic coating thicknesses in the range contemplated by applicant are well known in the art as evidenced by the teachings of MacMurray. It would have been an obvious expedient to modify the teachings of Bower by forming a wire tie having a plastic coating thickness known in the art motivated by the teachings of MacMurray. Regarding claim 3, the prior art clearly provides direction to the skilled artisan as to what plastics are suitable, e.g. polyvinyl chloride, and a suggestion as to a reasonable expectation of success in forming a wire tie using polyvinyl chloride resin. Hence, the specific polyvinyl chloride is not construed to be a matter of invention in the absence of factual evidence of record of patentably distinguishable properties directly related to the specific polyvinyl chloride resin used. As to claims 4 and 5, Bower teaches a wire tie comprising first and second resin coatings, as does applicant, wherein these resins are polyvinyl chloride, as contemplated by applicant. Accordingly, it is the examiner's position that since the results sought and the ingredients used were known, it was well within the expected skills of one having ordinary skill in this art to arrive at the optimum proportions of those ingredients. Moreover, there is no clear evidence on this record of

improved or unexpected properties of the instant claimed wire tie, said properties being directly related to the specific polyvinyl chlorides used and the proportions of each.

Therefore, the combined teachings of Bower and MacMurray would have rendered obvious the invention as claimed in present claims 1-8.

Response to Arguments

3. Applicant's arguments filed October 31, 2005 have been fully considered but they are not persuasive.

Applicants argue that neither Bower nor MacMurray disclose, teach, or suggest a wire tie with claimed structural features of a frictional-type textured surface which prevents slippage thus they fail to disclose, teach or suggest all the claim limitations of the present invention.

The examiner disagrees because the claims are not limited to a frictional textured surface, which prevents slippage. Furthermore, the serrations of MacMurray result in a wire tie having greatly improved holding power, or more specifically, a textured surface that prevents slippage and necessarily is a frictional type textured surface.

Applicants argue that there is nothing in the prior art that suggest a combination of Bower and MacMurray to arrive at the structure of the claimed invention, further arguing that there is no suggestion to modify the mechanical interlocking of MacMurray to achieve the frictional-type wire tie structure of the present invention, absent a suggestion to combine Bower and MacMurray to arrive at the claimed invention.

4. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to improve the holding power of the wire tie taught by Bower by including serrations in the plastic coating as taught by MacMurray.

Applicants argue that there is no reasonable expectation of successfully combining Bower and MacMurray to arrive at the claimed invention.

The examiner disagrees. The skilled artisan in this art concerned with wire ties that hold in use would have been reasonably motivated by the teachings of MacMurray to modify the surface of the wire tie taught by Bower with the expectation of enhancing the holding power of said wire tie.

No claims are allowed.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jill M. Gray
Primary Examiner
Art Unit 1774

jmg